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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,204	04/04/2005	Carlo Turi	2520-1054	9619

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EXAMINER

MCMAHON, MARGUERITE J

ART UNIT	PAPER NUMBER
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3747

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/530,204

Applicant(s)

TURI, CARLO

Examiner

Marguerite J. McMahon

Art Unit

3747

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) 7, 12, 16 and 19-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-11, 13-15 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Claims 7, 12 and 16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/29/06. Note that claims 12 and 16 were indicated as reading on the elected Species, but the examiner found that they do not read on the elected Species. In particular, claim 12 recites the two ferromagnetic opposed elements having a horseshoe shape, which is not shown in the elected Species represented by Figures 4-6, and claim 16 recites a vent, also not shown.

Newly submitted claims 19-21 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The septum as defined in claim 19 does not read on the elected Species, since it is defined as being located at the fuel inlet...between the walls and the cylindrical hub. This feature is shown in the non-elected species shown in Figure 7.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19-21 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The requirement is deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

Claims 1-6, 8-11, 13-15 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Note that the use of the word septum in claim 1 is misleading. A septum is a thin wall dividing two cavities or a partition. In the original drawings the "wall or septum 2" was shown as being the outer cylindrical wall of the housing. In the amended drawings, the septum 2 refers to the wall shown in Figure 7 which pierces the annular chamber and around which horseshoe shaped magnets are located. This Species is non-elected, and Applicant appears to be making an effort to include this non-elected Species within the purview of the claims drawn to the elected Species, but in the process, the clear articulation of the elected Species has been lost. There actually is no septum in the elected Species, represented by Figures 4-6, only a cylindrical wall, which forms the housing, as shown in the original Figures.

Note that the language of claim 10 is confusing since the subject of the phrase "having an alternate polarization" is unclear.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 13 and 17, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Johnston et al (5,055,188). Note a magnetic conditioning device for diesel engine fuel characterized in that it comprises a housing element 3, placed along the fuel feeding line, having a fuel inlet 1, a fuel outlet 16, providing a wall in correspondence of the inlet to deviate the inlet fuel, and an obliged path for the fuel, being provided two opposed permanent magnetic elements, 4 and 5, along said obliged path, inducing a magnetic field the flowing fuel, a central cylindrical hub 9, characterized in that said obliged path has such a shape to ensure a long passage of the fuel within the device, the device including an upper and lower lid 1b, 1a (see Figure 3). Note also a septum 7 configured to turbulently deviate the fuel, and projecting elements 9, which cause turbulence.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston et al (5,055,188) in view of Cox (6,178,953). Johnston et al show everything except utilizing neodymium magnets having a protective coating. Cox teaches that it is old in the art to employ neodymium magnets having a protective coating (see column 3, lines 52-54). It would have been obvious to one having ordinary skill in the art to modify Johnston et al by employing neodymium magnets having a protective coating as the

type of permanent magnets employed by Johnston et al, since this is a conventional type of permanent magnet.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston et al (5,055,188) in view of Sacs (6,849,188). Johnston et al show everything except employing ferrite as the permanent magnets. Sacs teaches that it is old in the art to employ permanent magnets made of ferrite (see column, lines 35-40, which mentions both ferrite and neodymium as choices for permanent magnets). It would have been obvious to one having ordinary skill in the art to utilize ferrite as the material for the permanent magnet, since this is conventional.

Allowable Subject Matter

Claims 8-11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 9/12/06 have been fully considered but they are not persuasive.

Applicant argues that the Johnston et al reference does not provide turbulence. In fact, Johnston et al reference does provide turbulence, since the members 7, 8 with the protruding hubs 9 will cause turbulence. In addition, a pathway that provides a tortuous, round-about flow path, as shown in the Johnston et al reference, will inherently produce turbulence.

Applicant argues several features (see page 19 of Applicant's remarks, which discuss the size and transversal section of the conduit, the fuel flow not being partitioned, or subjected to multiple passages through the magnetic field, the inlet and outlet openings being interchangeable, etc.), which are not included in the claims and therefore will not be addressed.

Applicant further argues that the septum, as shown in Figure 7, is not shown by the reference. As Figure 7 represents a non-elected Species, this argument is not relevant.

Applicant also discusses several other non-elected Species in a general way. With respect to claim 12, this claim has been withdrawn from further consideration, as it shows the two ferromagnetic opposed elements each having a horseshoe shape, which is not shown in the elected Species.

Applicant further argues that the prior art does not teach turbulence-causing projecting elements projecting into the obliged fuel path. As noted in the above rejection, Johnston et al show projecting elements 9, which cause turbulence.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marguerite J. McMahon whose telephone number is 571-272-4848. The examiner can normally be reached on Monday-Wednesday and Friday, 10am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Cronin can be reached on 571-272-4536. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marguerite McMahon
Primary Examiner
Art Unit 3747